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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,554	01/23/2004	Patrick Herelier	713-1048	3214
33712	7590	04/05/2005	EXAMINER	
LOWE, HAUPTMAN, GILMAN & BERNER, LLP (ITW) 1700 DIAGONAL ROAD SUITE 300 ALEXANDRIA, VA 22314			NASH, BRIAN D	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/762,554

Applicant(s)

HERELIER, PATRICK

Examiner

Brian Nash

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/23/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Examiner's Comments

1. This action is in response to applicant's preliminary amendment received 23 January 2004. Applicant amended the claims to remove the multiple dependencies of claims 4 and 6-8.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

3. Claims 3 and 6 are objected to because of the following informalities: Typographical errors in line 3 of claim 3, i.e. "canturn" and "in."; line 2 of claim 6, i.e. "be.". Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 4, 5 and 7 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with

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which it is most nearly connected, to make and/or use the invention. In claim 4, it is not clear how the lateral positioning plate is fixed, i.e. connect to, the bearing shoe. The term “indexing” does not enable one clearly understand how the two elements are fixed to one another.

In claim 5, how is indexing achieved by clicking, i.e. are two pieces of the apparatus rotated with respect to each other such that a clicking noise is produced when a protrusion of one element fits into a groove of the other element?

In claim 7, it is not clear how a stud “functionally widens” the lateral positioning plate?

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 3, it is not clear if the apparatus comprises a snout and is also equipped with a bearing shoe having a lateral positioning means or if applicant intends the claim to structurally limit the apparatus such that the snout itself contains the bearing shoe having a lateral positioning means. The examiner has construed claim 1 to define the former.

Claim 1 properly defines a bearing shoe and a lateral positioning plate; however, dependent claims 2-4 and 6 inconsistently refer to these as simply the plate or the shoe while other dependent claims properly refer back these elements as the bearing shoe and the lateral positioning plate. The examiner suggests that applicant amend the claims to be consistent.

In claim 3, it is not clear what structural limitations are encompassed by “circularly distributed”, i.e. is the lateral positioning plate a circular shape and the lateral bearing surfaces

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are distributed along its circumference? Also, the phrase “can turn and being held in place under the action of” is awkward and confusing and requires correction.

In claim 3, there is no antecedent basis for “the return means”.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,261,588 to Lin. Insofar as the claimed invention is understood, Lin shows the same apparatus for driving fasteners comprising a snout (12), a bearing shoe (32) having a lateral positioning plate (38) with several distinct bearing surfaces that are different distances from the axis of the snout (381,382, and others not referenced - see Figs. 1, 2, 5). Lin also shows the shoe connected to the lateral positioning plate via adjustable bolt (37), the adjustability serves to laterally move the bearing shoe along rail (22).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,261,588 to Lin in view of US 4,729,698 to Haddon. As discussed above, Lin discloses the invention substantially as claimed, but does not show a fastening apparatus and accompanying positioning device wherein the bearing shoe also serves to adjust the axial penetration of the fasteners along the vertical axis of the snout.

However, fastener tools having means for adjusting the penetration of its fasteners are well known in the art and it would be an obvious design modification to include such adjustability on the tool of Lin. As an example, Haddon shows a portable power tool having lateral and angular adjustability as well as a means for adjusting the vertical penetration of its driven fasteners (see abstract and Figs. 1, 3, 4).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pugsley, Umphress, Marsan, Wolff, Hall et al, Nasiatka, Miller and Dickhaut are cited to show related references.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Nash whose telephone number is 571-272-4465. The examiner can normally be reached on Monday – Thursday from 8 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached at 571-272-4467.

The official fax number for this Group is: 703-872-9306

Brian Nash
23 March 2005



Rinaldi I. Rada
Supervisory Patent Examiner
Group 3700